

TRADEMARKS
Attorney Docket 21327

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of U.S. Application Serial No. 78/208,649
For: X-TREK
Filed: January 29, 2003
Date of Publication: September 23, 2003



09-24-2003

U.S. Patent & TMO/tc/TM Mail Rpt Dt. #22

TREK BICYCLE CORPORATION)	
)	
Opposer,)	
)	
v.)	Opposition No. _____
)	
SILVERLIT TOYS)	
MANUFACTORY LTD.)	
)	
Applicant.)	

NOTICE OF OPPOSITION

In the matter of U.S. Trademark Application Serial No. 78/208,649 ("Serial No. 78/208,649") for the mark "X-TREK" in International Class 28, filed in the name of Silverlit Toys Manufactory Ltd. ("applicant"), which was published for opposition in the Official Gazette of September 23, 2003. Trek Bicycle Corporation ("Trek"), a Wisconsin corporation with its principal place of business at 801 West Madison, Waterloo, Wisconsin 53594, believes it will be damaged by the registration of the mark in Serial No. 78/208,649 and hereby opposes the same, in accordance with Section 13 of The Trademark (Lanham) Act of 1946, 15 U.S.C. §1063.

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Opposition Against "X-TREK"
Serial No. 78/208,649

As grounds for the opposition, Trek alleges as follows:

1. Upon information and belief, applicant is a Hong Kong corporation with a principal place of business at 1701-03 World Trade Centre, Gloucester Road, Causeway Bay, Hong Kong, Hong Kong.

2. Applicant seeks to register "X-TREK" in connection with the following goods.

"Toys, namely, remote controlled cars and tracks, controllers and accessories used therewith," in International Class 28;

as evidenced by the publication of Serial No. 78/208,649 in the Official Gazette of September 23, 2003.

3. Upon information and belief, applicant has filed its application under Section 1(b) of the Trademark Act [15 U.S.C. §1051(b)], claiming an intent to use the mark "X-TREK" for Class 28 goods.

4. Since at least 26 years prior to the filing of applicant's application for the mark "X-TREK," Trek adopted and has continuously used the trade name "TREK" in connection with its business activities.

5. Trek has invested substantial amounts of time, effort and money in protecting and policing its "TREK" trade name throughout the United States and the rest of the world. As such,

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Trek has extensive, non-registered statutory and common law rights in its "TREK" trade name, which Trek uses in connection with its business activities.

6. Since at least 25 years prior to the filing of applicant's application for the mark "X-TREK," Trek has continuously used its "TREK" mark in connection with bicycles, bicycle frames, bicycle parts and accessories; Trek also has expanded its trademark use of "TREK" to cover numerous products and services, including, among other things, toy finger bikes, computer games and video games.

7. Trek has invested substantial amounts of time, effort and money in registering, promoting and policing its famous "TREK" trademark throughout the United States and the rest of the world. As such, in addition to the protection afforded Trek by its federal trademark registrations, Trek has extensive, non-registered statutory and common law rights in its "TREK" mark for its products and services.

8. Trek is the owner of U.S. Trademark Registration No. 1,168,276 for "TREK" for "bicycles and bicycle frames"; U.S. Trademark Registration No. 1,989,281 for "TREKKING" for "bicycles"; U.S. Trademark Registration No. 1,994,479 for "TREK 100" for "providing ride support vehicles in competitive and

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13. Applicant's mark "X-TREK" so resembles Trek's "TREK" mark and trade name that, when used on or in connection with applicant's goods, it is likely to cause confusion, or to cause mistake or to deceive within the meaning of Section 2(d) of The Trademark (Lanham) Act of 1946, 15 U.S.C. § 1052(d); and more particularly, applicant's mark and use thereof are likely to cause confusion in, or to cause mistake by, or to deceive the trade and purchasing public into believing that applicant's goods originate with Trek or otherwise are authorized, licensed or sponsored by Trek.

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14. By reason of all the foregoing, Trek will be gravely damaged by the registration of applicant's "X-TREK" mark, because registration of that mark would be in violation of Trek's trademark and trade name rights.

WHEREFORE, Trek prays that this Notice of Opposition be sustained in favor of Trek and that Serial No. 78/208,649 be denied registration. Trek submits herewith a copy of this Notice

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of Opposition, along with a check to cover its filing fee of
\$300.00, as required by 37 C.F.R. §2.6(a)(17).

Respectfully submitted,

TREK BICYCLE CORPORATION

Date: 9/24/03

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CERTIFICATE OF MAILING BY "EXPRESS MAIL"

"Express Mail" mailing label number: EV201553880 US

Date of Deposit: September 24, 2003

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" Service under 37 C.F.R. 1.10 on the date indicated above and is addressed to the Commissioner for Trademarks, BOX TTAB - FEE, 2900 Crystal Drive, Arlington, Virginia 22202-3513.

Amy Muran Felton

TTAB

TRADEMARKS

Attorney Docket No. 21327

Date: September 24, 2003

COMMISSIONER FOR TRADEMARKS

BOX TTAB - FEE

2900 Crystal Drive

Arlington, VA 22202-3513

Transmitted herewith is the:

☒ Trademark

☐ Service Mark

☐ Application

☒ Notice of Opposition

☐ Office Action Response

☐ Petition to Cancel

☐ Combined Sections 8 and 9 Declaration

☐ Combined Sections 8 and 15 Declaration

In the Matter of U.S. Application Serial No. 78/208,649

For: X-TREK



Also enclosed are:

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☒ Notice of Opposition in duplicate

☒ Check No. 6462 for \$300.00

In the unlikely event that insufficient funds are submitted herewith to cover the filing fee in this correspondence, please charge such funds against Deposit Account No. 50-0277.

Respectfully submitted,

Enclosures

By: Amy Merz

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